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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/276,868 03/26/99 SIMONS

M BIS-043

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HM22/1009

EXAMINER

KAM, C

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

10/09/01

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application N .

09/276,868

Applicant(s)

SIMONS ET AL.

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____ .

DETAILED ACTION

In view of the claims, it would be appear the restriction of the inventions is required.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:
 - I. Claims 1, 3-5 and 7-10, drawn to a method for stimulating angiogenesis within a targeted collection of viable cells in-situ under in vivo or in vitro conditions using the PR-39 oligopeptide collective, classified in class 514, subclasses 12 and 15.
 - II. Claims 1 and 6, drawn to a method for stimulating angiogenesis within a targeted collection of viable cells in-situ using the DNA sequence encoding the PR-39 oligopeptide collective, classified in class 514, subclass 44.
 - III. Claims 2, 3-5, 7-10, drawn to a method for altering proteasome-mediated degradation of peptides in-situ within a targeted collection of viable cells under in vivo or in vitro conditions using the PR-39 oligopeptide collective, classified in class 514, subclasses 12 and 15.
 - IV. Claims 2 and 6, drawn to a method for altering proteasome-mediated degradation of peptides in-situ within a targeted collection of viable cells using the DNA sequence encoding the PR-39 oligopeptide collective, classified in class 514, subclass 44.
 - V. Claims 11-15, drawn to a family of PR-39 derived oligopeptides which cause an inhibition of proteasome-mediated degradation of peptides in-situ after introduction intracellularly to a viable cell, classified in class 514, subclasses 12 and 15.

Should Group I or III be elected, applicant is required to elect the method under in vivo or in vitro conditions. The method under in vivo conditions is distinct from the

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method under in vitro conditions because each method has different method steps, performs under different conditions and produce different effects

2. The inventions are distinct, each from the other because of the following reasons:

The product of Invention V and the methods of Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the methods of Inventions I and III are alternative processes of use of the product of Invention I.

The methods of Inventions I-IV are distinct from each other because each Invention has different method steps, performs under different conditions and produces different effects. For example, Inventions I and II are methods for stimulating angiogenesis, however, Group I is carried out under in vivo or in vitro conditions using the PR-39 derived oligopeptides, while Group II is related to gene therapy using DNA encoding the PR-39 derived oligopeptides; Inventions III-IV are methods for altering proteasome-mediated degradation of peptides in-situ, however, Group III is carried out under in vivo or in vitro conditions using the PR-39 derived oligopeptides, while Group IV is related to gene therapy using DNA encoding the PR-39 derived oligopeptides.

The product of Invention V is distinct from the methods of Invention II and IV because the product of Invention V can be neither made by nor used in the methods of II and IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent

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subject matter, and because inventions I-V require different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to David Prashker on October 4, 2001 to request an oral election to the above restriction requirement, but could not reach the attorney.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D.
Patent Examiner

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October 4, 2001

Christopher S. F. Low

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SUPERVISORY PATENT EXAMINER
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